

**REMARKS**

This is in response to the Office Action that was mailed on December 4, 2002. Claim 22 is cancelled -- without prejudice to the subject matter thereof -- in order to facilitate the prosecution of this application. No new matter is introduced by this Amendment, and no new issues are raised thereby. Accordingly, entry of this Amendment in order to place the application into condition for allowance, or into better condition for appeal, is respectfully solicited. With this Amendment, claims 1-3 and 14-21 are in the application.

It is noted that the outstanding Office Action does not state any grounds of rejection or objection with respect to claims 3 and 14-21. The Examiner alleges that "Claims 3-20 are drawn to a non-elected invention". The Examiner is respectfully requested to modify the requirement for restriction, and to treat all of the pending claims -- that is, 1-3 and 14-21 -- on their merits.

The significance of the present invention resides in its provision of a class of imide catalysts that can be used in a class of reactions to produce classes of compounds, not in the production of each individual compound. Applicants respectfully submit that it is of no value that raw materials and reaction products are defined as compounds.

Claims 1, 2, and 22 were rejected under the second paragraph of 35 U.S.C. §112 as failing to define the invention properly. Claim 22 has been cancelled. The rejection is respectfully traversed with respect to claims 1 and 2.

The Examiner alleges that the claims are rendered indefinite by the terminologies "organic compound", "compound capable of forming a stable radical", and "oxygen-atom-containing compounds". None of these terminologies is *per se* indefinite, particularly to the sophisticated chemistry experts to which

present disclosure is directed. Also, each of these terminologies is qualified in the claims. The "organic compound" is a reaction product of compounds (A) and (B). The "compound capable of forming a stable radical" is selected from compounds (A1), (A2), and (A3). The "oxygen-atom-containing compounds" are those which have a carbon-hydrogen bond at the adjacent position to an oxygen atom and which are capable of forming a stable radical. Moreover, each of these terminologies is supported by explanatory disclosure in Applicants' lengthy specification.

The Examiner indicates that synthetic processes are classified by the PTO based upon the products which they produce, and that the present claims would therefore fall within a large number of different subclasses. The statute does not require that applicants define their invention in terms of the PTO classification system, but only that applicants particularly point out and distinctly claim what they regard as their invention. In this case, Applicants' invention relates to the use of a particular **class** of imide compounds to catalyze a **class** of reactions.

Specifically, the invention relates to a process of allowing two compounds to react with each other in the presence of a specific imide compound and a radical generator with respect to the imide compound to yield a product of an addition or substitution reaction or an oxidized product thereof by a radical mechanism.

Specification, page 1. Since all of the processes of the present invention require the utilization of the specified imide compound, any search for relevant prior art should presumably include a search keyed to the imide compounds. In any case, search considerations are manifestly irrelevant to considerations of compliance with 35 U.S.C. §112.

The presently claimed synthetic process involves the reaction of two classes of compounds, designated in claim 1 as (A) and (B). Claim 2 reacts a species of (A) designated as (A11) and a species of (B) designated as (B11). Claim 3 reacts a species of (A) designated as (A11) and a species of (B) designated as (B12). Claim

14 reacts a species of (A) designated as (A12) and a species of (B) designated as (B13). Claim 15 reacts a species of (A) designated as (A13) and a species of (B) designated as (B11). Claim 16 reacts a species of (A) designated as (A31) and a species of (B) designated as (B11). Claim 17 reacts a species of (A) designated as (A31) and a species of (B) designated as (B14). Claim 18 reacts a species of (A) designated as (A31) and a species of (B) designated as (B15). Claim 19 reacts a species of (A) designated as (A11) and a species of (B) designated as (B21). Claim 20 reacts a species of (A) designated as (A32) and a species of (B) designated as (B22). Claims 1 and 21 are generic as to compounds (A) and (B).

Claims 1-3 and 14-21 herein clearly define generic and specific aspects of a single invention in the manner prescribed by the second paragraph of 35 U.S.C. §112. The rejection of record cannot be sustained.

### **Conclusion**

If the Examiner has any questions concerning this application, he is requested to contact Richard Gallagher, Reg. No. 28,781, at (703) 205-8008.


If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

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Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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RCS/RG 

Attachment:

Clean copy of claims pending in this application